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In re Application of : DECISION
Niro Nakamichi et al. : TERMINATING
Application No. 08/760,706 : REISSUE PROCEEDING
Filed: December 5, 1996
Practitioner Docket No.: 004076.73577

This is a decision terminating the instant reissue proceeding based on: (1) the expiration of U.S. patent 5,123,001, for which patent the present application requests reissue; and (2) the failure of applicants to provide sufficient basis for examination of reissue application No. 08/760,706 in response to the April 13, 2007 Second Order to Show Cause.

BACKGROUND

1. Reissue application No. 08/760,706 ("the '706 reissue application") was filed on December 5, 1996, for reissue of U.S. Patent No. 5,123,001 ("the '001 patent") issued June 16, 1992.
2. The Image File Wrapper record for the '706 reissue application reveals that a response to the Office communication of September 10, 2004, was filed on October 8, 2004.
3. The Office's financial records reveal that the 11.5 year maintenance fee due by June 16, 2004 (the end of the maintenance fee grace period), was not paid. As a result, the '001 patent expired at midnight on June 16, 2004, for failure to pay the 11.5 year maintenance fee due.¹ See: 1285 OG 49, 50 (August 10, 2004).
4. On July 11, 2006, the Office issued an Order to Show Cause for the '706 reissue application stating that (i) the '001 patent expired for failure to pay the third maintenance fee, (ii) the Director of the USPTO no longer had the authority under 35 U.S.C. § 251 to reissue the '001 patent, and (iii) the Office intended to terminate the present reissue proceeding and hold the '706 reissue application to be an

¹ See: MPEP § 2506, third paragraph.

abandoned application. The Order gave applicants a period of 30 DAYS from its mailing date to show cause why the Office should not terminate the present reissue proceeding.

5. In response to the July 11, 2006 Order, applicants filed a communication titled "Response to Order to Show Cause" on August 10, 2006. The August 10, 2006 Response requested that prosecution of the '706 reissue application be continued, because of applicants' August 10, 2006 petition under 37 CFR 1.378(b) to reinstate the '001 patent due to unavoidable delay in timely payment of the third maintenance fee. The August 10, 2006 petition under § 1.378(b) in the '001 patent included a payment of the 11.5 year maintenance fee.
6. On April 13, 2007, the Office issued a Second Order to Show Cause in the '706 reissue application stating that (i) the '001 patent expired for failure to pay the third maintenance fee, (ii) the Director of the Office no longer had the authority under 35 U.S.C. § 251 to reissue the '001 patent, and (iii) the Office intended to terminate the present reissue proceeding and hold the '706 reissue application to be an abandoned application. The Second Order also stated that the August 10, 2006 Response to Order to Show Cause was sufficient only to the extent that the Office would not terminate the present reissue proceeding at that time. The Second Order gave applicants six months from its mailing date to again show cause why the Office should not terminate the present reissue proceeding.
7. In response to the April 13, 2007 Second Order, applicants filed a communication titled "Response to Second Order to Show Cause" on October 13, 2007. In the October 13, 2007 Response, applicants stated that, on April 27, 2007, they received a decision dismissing the August 10, 2006 petition to accept an unavoidably delayed payment of the third maintenance fee in the '001 patent. Applicants' requested, in the October 13, 2007 Response, that prosecution of the '706 reissue application be continued, because of applicants' June 27, 2007 renewed petition, requesting reconsideration of the April 27, 2007 decision.
8. On December 22, 2008, the Office mailed to the correspondence address of record in the '001 patent a decision denying the June 27, 2007 renewed petition to accept an unavoidably delayed payment of the third maintenance fee in the '001 patent. The December 22, 2008 decision states that it is a final agency action.
9. On December 29, 2008, the December 22, 2008 decision was returned to the Office as undeliverable mail. A courtesy copy of the December 22, 2008 decision was mailed on May 12, 2009, to counsel's mailing address identified in the June 27, 2007 renewed petition.
10. No further updated response to the April 13, 2007 Second Order to Show Cause has been received by the Office.

DECISION

As pointed out above, the December 22, 2008 decision in the '001 patent was a final agency action denying the June 27, 2007 renewed petition to accept an unavoidably delayed payment of the third maintenance fee. Accordingly, the '001 patent remains in the status of an expired patent for failure to pay the third maintenance fee.

When a patent has expired, the Director of the USPTO no longer has the authority under 35 U.S.C. 251 to reissue the patent. See *In re Morgan*, 990 F.2d 1230, 26 USPQ2d 1392 (Fed. Cir. 1993). As stated in *Morgan*,

"The language of section 251 is unambiguous: the Commissioner has authority to reissue a patent only 'for the unexpired part of the term of the original patent.' Thus, when Morgan's original patent expired on August 19, 1992, the Commissioner was divested of his reissue authority because there no longer was an unexpired term of the patent for which Morgan's patent could be reissued. Morgan's appeal thus became moot." [990 F.2d at 1231, 26 USPQ2d at 1393.] [Emphasis added.]

Since the '001 patent expired for failure to pay the requisite maintenance fee, and applicants have not provided sufficient basis for examination of the '706 reissue application, the '706 reissue application is hereby terminated.

CONCLUSION

1. The present reissue application is hereby terminated. This is not a final agency decision.
2. Jurisdiction over the present reissue application file is being retained by the Office of Patent Legal Administration for TWO MONTHS from the mailing of this Decision to provide patent owner with an opportunity to respond. If a response is not received within the TWO MONTH time period, jurisdiction over the reissue application file will be forwarded to Technology Center Art Unit 2600 for processing the application as an abandoned application.
3. Telephone inquiries related to this decision should be directed to Raul Tamayo, Legal Advisor, at (571) 272-7728.



Kenneth M. Schor
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